

REMARKS

Within the present Official Action, the PTO has rejected claims 1-23, 25 and 26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,747,133 to *Vinod et al.* in view of U.S. Patent No. 5,932,337 to *Edinger et al.* The PTO states that *Vinod et al.* describes a flexible floor covering having several layers with a fabric layer having an embedded plastic matrix whereby the fabric may be nonwoven. The PTO further states that *Vinod et al.* is silent about the weight basis of the nonwoven reinforcing material and the components comprised in the cover layer. However, the PTO states that *Edinger et al.* describes a floor covering with a cover layer made from a combination of epoxidation products of subesters of polycarboxylic acids and polyethylene glycols. Additionally, the PTO continues to maintain that the weight basis limitation would have been obvious to one of ordinary skill in the art since optimization of such a range would have been obvious.

In response to Applicants' previous arguments asserting that the prior art does not teach or suggest combining the two cited references, the PTO states that references are to be evaluated by what they suggest to one skilled in the art rather than by their specific disclosures. Applicants contend that the suggestion to combine the art must still come from the specific references. While the references are not required to specifically refer to the desired combination, the references must at least contain a suggestion that such a combination must occur. Applicants respectfully request that the PTO provide the suggestion from the cited art for combining the two references.

Additionally, the PTO has acknowledged that the prior art does not teach the claimed basis weight limitation of the present application. However, the PTO asserts that the claimed basis weight recited in independent claims 1 and 26 would have been obvious to one of ordinary skill in the art to optimize the claimed range of the basis weights, since the references describe the components of the floor covering. Applicants again point out that the

PTO has failed to provide any references that teach a weight basis, let alone the claimed range for the weight basis.

The PTO states that the optimization of the weight basis range would have been obvious to one of ordinary skill in the art. Applicants respectfully note that in order to optimize something, it first must be suggested in the prior art. A result effective variable, such as the claimed weight basis, requires that there must be some suggestion to vary the weight basis found in the cited art. As admitted by the PTO, the prior art is silent as to the weight basis. Thus, it would not have been obvious to one of ordinary skill in the art to have optimized it. As stated at MPEP § 2144.05, a particular parameter first must be recognized as a result effective variable, i.e., a variable which achieves a recognizable result, before the determination of an optimized arrangement of said variables might be characterized as a routine experimentation. In the present case, the prior art is silent as to the recognition of such a result effective variable. Therefore, it would not have been obvious to one of ordinary skill in the art. Thus, Applicants respectfully contend that that which is claimed in the present application is neither taught nor suggested in the cited prior art.

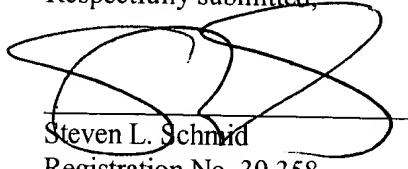
Additionally, the PTO states that it would have been obvious to one of ordinary skill in the art to modify components of the cover layer of the flooring cover of *Vinod et al.* with the components of the cover layer of *Edinger et al.* motivated by the expectation that improved properties of wear and decorative appeal would be enhanced as noted by *Vinod et al.*, column 2, lines 29-39. Applicants respectfully point out that column 2, lines 29-39, of *Vinod et al.* is not directed to improved wear properties but instead states that the optimum cushioning layer may comprise fiber felt and that, if desired, a transparent flexible wear layer may be included. Thus, this reference is silent as to improved wear properties of combining the claim components of the present application. Thus, Applicants respectfully assert that there is no motivation for combining the two references.

Thus, Applicants respectfully submit that claims 1-23, 25 and 26 of the application are believed to be in condition for allowance and an early notice to such effect is earnestly solicited.

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Respectfully submitted,


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

August 12, 2003

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